

Application No. 09/623,010
Art Unit 1713
January 21, 2004
Reply to Office Action of October 21, 2003

REMARKS

It is respectfully requested that the present Amendment be entered into the Official File in view of the fact that the following remarks and submitted Declaration automatically place the application in condition for allowance. In the alternative, if the Examiner continues with the rejections of the present application, it is respectfully requested that the present Reply be entered for purposes of an Appeal. The present Reply reduces the issues on appeal by reducing the number of claims and overcoming at least the rejection under 35 U.S.C. § 102(b). Thus, the issues on appeal would be reduced.

No new matter has been added with the amendment to the present specification. These changes are editorial in nature (please also see paragraph 11 of the Office Action).

Claims 1-13 are pending in this application. In view of the following remarks, Applicants respectfully request that the Examiner withdraw all rejections and allow the currently pending claims.

Issues Under 35 U.S.C. §§ 102(b) and 103(a)

Claims 10, 12 and 13 stand rejected under 35 U.S.C. § 102(b) as being anticipated by EP '096 (European Patent Application No. EP 0 690 096 A1), as stated in paragraphs 5-8 of the Office Action.

Application No. 09/623,010
Art Unit 1713
January 21, 2004
Reply to Office Action of October 21, 2003

Also, claims 10, 12 and 13 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over EP '096 in view of Kometani '913 (U.S. Patent No. 3,951,913), Sonoii '686 (U.S. Patent No. 4,929,686) or Yamamoto '902 (U.S. Patent No. 5,478,902), as stated in paragraphs 9-10 of the Office Action. Applicants respectfully traverse.

EP '096

The Office Action states that the rejection in view of EP '096 is still valid because: "EP '096 specifically teaches the use of a tertiary amine such as DABCO (diazabicyclooctane) ... HF is known to be liberated during the cure and with bisphenols or their salts, it would form a salt with the tertiary amine ... " (paragraph 6 of the Office Action).

Applicants respectfully traverse such conclusions, and further submit that patentable distinctions exist over EP '096. In support of Applicants' position of patentability, a Declaration pursuant to 37 C.F.R. § 1.132 is hereby submitted (by co-inventor Kiyotaro Terasaka). As can be seen in the enclosed Declaration, using free DABCO as suggested in the Office Action cannot achieve the effects of the present invention. Specifically, when free DABCO is used as a curing accelerator for a fluoroelastomer curing composition, the stability of the composition is not satisfactory (see Table A in the

Application No. 09/623,010
Art Unit 1713
January 21, 2004
Reply to Office Action of October 21, 2003

Declaration). Instead, the cured film that is prepared with such a composition cannot achieve good properties and is inferior to the present invention, such as seen with the measured property of elongation (again, see the results shown in Table A of the Declaration). Thus, DABCO would not form a salt with HF that is liberated during the cure with bisphenols or their salts, as asserted. Accordingly, Applicants respectfully maintain their position that the EP '096 reference fails to disclose all features as instantly claimed. Reconsideration and withdrawal of this rejection are respectfully requested.

Applicants are unable to understand and respond to the statements in paragraph 7 of the Office Action. The reaction between DBU-b and benzyl chloride is an acid-base reaction; the reaction between benzoic acid and ethanol involves a dehydration reaction. These are different reaction mechanisms. If needed, clarification is respectfully requested.

EP '096 in view of Kometani '913, Sonoi '686 or Yamamoto '902

With regard to the rejections under 35 U.S.C. § 103(a), Applicants respectfully traverse for the same reasons stated above and assert that the present invention is patentably distinguishable over the cited combinations of references. The deficiencies of EP

Application No. 09/623,010
Art Unit 1713
January 21, 2004
Reply to Office Action of October 21, 2003

'096 have been pointed out, and the cited secondary references do not account for such deficiencies of the primary reference.

Applicants also respectfully submit that the present invention has achieved unexpected results (i.e., see Table A of the submitted Declaration, as well as the experimental data shown in the previous Declarations), which rebuts any asserted *prima facie* case of obviousness. For instance, the present invention is more stable and has a longer pot life when compared to any composition related to the references. Also, the Examiner cites the disclosure of DABCO in EP '096, which appears to be what the Examiner considers the closest prior art example. Thus, Applicants respectfully refer the Examiner to the submitted Rule 132 Declaration, whereby the present invention unexpectedly achieves better results over such the comparative example (a comparative showing need not compare the claimed invention with all of the cited prior art, but only with the closest prior art; see MPEP §§ 716.02(b) and 716.02(e); see also *In re Fenn et al.*, 208 USPQ 470 (CCPA 1981)). The EP '096 embodiment is not even relatively stable when compared to the present invention. Thus, based on these distinctions, reconsideration and withdrawal of these rejections are respectfully requested.

Application No. 09/623,010

Art Unit 1713

January 21, 2004

Reply to Office Action of October 21, 2003

Conclusion

Based on the above remarks, Applicants respectfully maintain their position that patentable distinctions exist for the present invention.

A full and complete response has been made to all issues as cited in the Office Action. Applicants have taken substantial steps to advance prosecution of this case. Thus, Applicants respectfully request that a timely Notice of Allowance be issued in the present case.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Eugene T. Perez (Reg. No. 48,501) at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

Application No. 09/623,010
Art Unit 1713
January 21, 2004
Reply to Office Action of October 21, 2003

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

BIRCH, STEWART, KOLASCH & BIRCH, LLP

By 

Andrew D. Meikle, #32,868

ADM/ETP
0020-4744P

P.O. Box 747
Falls Church, VA 22040-0747
(703) 205-8000

Attachment: Declaration Under 37 C.F.R. § 1.132